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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,556	03/21/2001	Eiichi Ito	108863	2650

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EXAMINER

LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application No.

09/812,556

Applicant(s)

ITO ET AL.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to applicant's request for restart period of reply filed on July 8, 2003.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "15" has been used to designate both as a public line switching station (Figure 1) and as a wireless device (cellular, Figure 19).
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
 - Elements CS, S510, S527, S545, S827, S837 and 76 are not described in the specifications.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
 - Element S858 is not illustrated in the drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to because of the following informalities:
 - Paragraph 15 Line 13, change "2" as --22--.
 - Paragraph 16 Line 8, add --printhead-- before "26".
 - Paragraph 36 Line 6, change "Fig. 2" as --Fig. 12--.

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Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. **Claims 4,5,8,9 and 17 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, it is unclear if the storing device is to store personalized product in association with customer information (how is going to be pack) or if is to store the personalized product data in association with the customer information (database).

Also, Claim 4 recites the limitation "produced personalized product" in line 2. It is unclear if the produced personalized product cited is the same produced personalized product recited in line 1 of claim 1.

As to claim 5, it is unclear in claim 5 how the email received by the customer contains information of the personalized product-producing device location and how the customer "design" it. For example, how is going to design the location, does the customer choose the location or the supplier and how the email send by the customer has the location if the customer doesn't know where is the personalized product is going to be made.

As to Claim 17, the claim recites the limitation "the personalized product producing data in a first format" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-6 and 10-17 are rejected** under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks) and further in view of US Pat No 6,134,548 to Gottsman et al (Gottsman).

Regarding claims 1-3,6,12,13 and 16, Rubber Stamp discloses a personalized product producing system comprising an electronic mail receiver that receives emails from different customers. Each email contains data of the requested personalized product along with customer information (See page 2, a customer can send an email to Rubber Stamp to place an order and can provide postal address, phone number or email address in order to deliver the product completed).

A data analyzer that analyzes the content of the email and converts the content to image data to be outputted (a worker or a machine at Rubber Stamp look at the content of the emails and convert the data into an image to be created).

A personalized product-producing device that receives the image data and outputs an image (the product).

However, Rubber Stamp fails to disclose that the email is send by a customer by wireless communication and that two emails will be sent to the customer, one to confirm that the order was receive and one to confirm that the product is completed.

Current Checks teaches that is known in the art to have a feedback service that when a person send an email (see Page 10), the system will send an email to the customer to confirm that the order was receive and another to confirm that the product is completed (see Page 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a feedback service, as taught by Current Checks, into a system as described by Rubber Stamps, in order to be polite and kind to the customer in order to have him back for further purchases.

As to the fact that Rubber Stamp fails to disclose that the email is send by a customer by wireless communication, Gottsman teaches that it is known in the art the use of cellular or palms devices, known wireless devices, to send and receive emails (Figure 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wireless device, as taught by Gottsman, into a system as described by Rubber Stamps, in order to give the customer different ways to enter his order.

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As to claim 4, Rubber Stamp discloses a storing device for storing the personalized product in association with the customer information (each personalized product from the different customers are separately and individually storage, i.e. box, etc; or each personalized product data from the different customers are separately and individually storage, i.e. database, etc).

As to claim 10, Rubber Stamp discloses that the system further includes an estimated time calculator that detects the amount of email received and calculates the estimated time of completion (Rubber Stamp delivers depends on the selection of the customer from next or Priority, see Pages 2 and 4).

As to claim 11, Rubber Stamp discloses that the personalized product-producing device produces an engraved stamp (see Page 1, list of products).

As to claims 14 and 15, Rubber Stamps fails to disclose that the product produced are name cards or sticker/labels. Rubber Stamps produce personalized stamps (see Page 1).

Current Checks teaches that the personalized product-producing device produces a name card or a sticker/label (see Page 9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make name cards or sticker/labels, because the product will not affect the process of receiving the order from the customer. Furthermore, it also could be obvious to Rubber Stamps produce name cards or sticker/labels in order to expands their personalized products and bring more customers to make purchases.

As to claim 17, Rubber Stamp discloses a plurality of types or designs (see Pages 3 and 4).

10. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over RubberStampsnow.com (Rubber Stamp) in view of CurrentChecks.com (Current Checks), US Pat No 6,134,548 to Gottsman et al (Gottsman) and further in view of US Pat No 5,732,398 to Tagawa.

Rubber Stamp, as modified by Current Checks and Gottsman, fails to disclose that there is more than one location where the email of the customer can be send and that the personalized product producing system is installed in an amusement facility and the email receiver is installed in a plurality of pavilions.

Tagawa teaches that is known in the art to have a network (Figure 2a) with more than one location (50,54 and 60) and a plurality of pavilions (Regional Reservation Centers 1-3), wherein a person can send an email (request for travel information) through the different locations (kiosks 50,54 and 60) to another regional centers (Col. 8 Line 51 to Col. 9 Line 33). Also, the personalized product producing system (kiosk) is installed in an amusement facility (geographical region with dense population centers or with many local tourist attractions, Col. 8 Lines 51-62).

Applicant is reminded that the duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more than one location, as taught by Tagawa, into a

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system as described by Rubber Stamps, as modified by Current Checks and Gottsman, in order to give the customer a diversity of places where he can send his order conveniently.

11. Claims 1-6 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,801,944 to Kara in view of CurrentChecks.com (Current Checks) and further in view of US Pat No 6,134,548 to Gottsman et al (Gottsman).

Regarding claims 1-3,6,12,13 and 16, Kara discloses a personalized product producing system comprising a data analyzer that analyzes the content of the order and converts the content to image data to be outputted.

A personalized product-producing device that receives the image data and outputs an image (Col. 2 Lines 10-23).

However, Kara fails to disclose that the order is received by email (by wireless communication) and that two emails will be sent to the customer, one to confirm that the order was received and one to confirm that the product is completed.

Current Checks teaches that is known in the art to have a feedback service that when a person send an email (see Page 10), the system will send an email to the customer to confirm that the order was received and another to confirm that the product is completed (see Page 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a feedback service, as taught by Current Checks, into a system as described by Kara, in order to be polite and kind to the customer in order

to have him back for further purchases and to give another way to the customer to buy a product.

As to the fact that Kara fails to disclose that the email is send by a customer by wireless communication, Gottsman teaches that it is known in the art the use of cellular or palms devices, known wireless devices, to send and receive emails (Figure 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a wireless device, as taught by Gottsman, into a system as described by Rubber Stamps, in order to give the customer different ways to enter his order.

As to claim 4, Kara discloses a storing device for storing the personalized product in association with the customer information (each personalized product from the different customers are separately and individually storage, i.e. box, etc; or each personalized product data from the different customers are separately and individually storage, i.e. database, etc).

As to claim 10, Kara discloses that the system further includes an estimated time calculator that detects the amount of email received and calculates the estimated time of completion (Col. 2 Lines 10-23).

As to claim 11, Kara discloses that the personalized product-producing device produces an engraved stamp (Col. 2 Lines 10-15).

As to claims 14 and 15, Kara discloses that the personalized product-producing device produces a name card or a sticker/label (Col. 2 Lines 10-15).

As to claim 17, Kara illustrates a plurality of types or designs (address labels, greeting cards, etc).

12. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,801,944 to Kara in view of CurrentChecks.com (Current Checks), US Pat No 6,134,548 to Gottsman et al (Gottsman) and further in view of US Pat No 5,732,398 to Tagawa.

Kara, as modified by Current Checks and Gottsman, fails to disclose that there is more than one location where the email of the customer can be send and that the personalized product producing system is installed in an amusement facility and the email receiver is installed in a plurality of pavilions.

Tagawa teaches that is known in the art to have a network (Figure 2a) with more than one location (50,54 and 60) and a plurality of pavilions (Regional Reservation Centers 1-3), wherein a person can send an email (request for travel information) through the different locations (kiosks 50,54 and 60) to another regional centers (Col. 8 Line 51 to Col. 9 Line 33). Also, the personalized product producing system (kiosk) is installed in an amusement facility (geographical region with dense population centers or with many local tourist attractions, Col. 8 Lines 51-62).

Applicant is reminded that the duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more than one location, as taught by Tagawa, into a


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system as described by Kara, as modified by Current Checks and Gottsman, in order to give the customer a diversity of places where he can send his order conveniently.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents cited further show the state of the art with respect to order-personalized products.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo. The examiner phone number is (703)-305-9747. The fax number for correspondence before a final action is (703)-872-9326 and the fax number for correspondence after final action is (703)-872-9327. The email direction of the examiner is carlos.lugo@uspto.gov. The examiner can normally be reached on Monday to Friday from 9:30am to 6:30pm (EST). If the examiner is not available, please leave a message, including the application number and the examiner will answer the message as soon as possible.

CL
August 14, 2003


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